

REMARKS

Claims 1, 9 and 10 were pending in the application. Claims 11 and 12 are added as new claims. Support for the new claims is found, for example, at page 3, line 28 to page 4, line 13 after formula (6) and page 6, lines 7-18. No new matter is presented.

I. Response to Rejection under 35 U.S.C. § 103

Claims 1, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oharu et al. (U.S. Patent No. 6,610,775).

In the Response filed August 9, 2007, Applicant noted that none of the exemplified compounds of Oharu et al include an isotridecyl group such that there is no apparent reason to employ such compound as suggested by the Examiner. At best, the Examiner is saying, in effect, that it is obvious to try any non-ionic surfactant having a branched or linear alkyl chain to arrive at the present invention. The applicable law is to the contrary. *See, e.g., In re Sigco*, 36 USPQ2d 1380, 1382 (Fed. Cir. 1995) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1521, 1532 (Fed. Cir. 1988) (rejecting the "obvious to try" standard)); *In re Deuel*, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995) ("obvious to try" has long been held not to constitute obviousness").

Moreover, Oharu et al does not teach, suggest or recognize the advantageous effects that a surfactant having an isotridecyl group can impart an aqueous water- and oil-repellent dispersion. In support thereof, Applicant's executed Declaration under 37 C.F.R. § 1.132 explains the differences between the surfactant of the present invention and that taught by Oharu et al. The Declaration further shows that the present invention provides unexpectedly superior results when compared to the closest prior art based on a comparison of the inventive examples to Comparative Example 4 of the present specification. Comparative Example 4 employs

polyoxypropylene polyoxyethylene cetyl ether, which corresponds to formula 5 of Oharu et al wherein the R¹⁰ group is a C₁₆ n-cetyl group having a straight structure, and specifically the compound at col. 10, line 3 of Oharu et al. The compound of Oharu et al, gives poor properties such as durability of repellency and mechanical property as shown in Table B at page 17 of the present specification. In contrast, inventive Examples 1-4, employing a surfactant having the specific isotridecyl group defined in present claim 1, give excellent properties as shown in Table B. Thus, the present invention is patentable over Oharu et al.

In the Advisory Action mailed August 24, 2007, the Examiner states that Applicant continues to argue that the examples in Oharu et al do not include a branched structure. The Examiner further states that Applicant fails to recognize that teachings Oharu et al also include branched structures in the Declaration.

Applicant respectfully submits that the Examiner has mischaracterized Applicant's arguments presented in the Response filed August 9, 2007 and in view of this error, has failed to properly consider the Declaration evidence.

Applicant pointed out that Oharu et al does not teach the specific isotridecyl compound of the present claims, but did not state that Oharu et al does not include a branched structure. On the contrary, the Declaration clearly states that the fifth specific example at column 10, lines 1-7, of Oharu et al has a branched structure for R¹⁰. Thus, there is no failure to recognize that Oharu et al includes at least one branched structure. Furthermore, the branched structure of Oharu et al is not an isotridecyl group.

With the filing of this RCE, Applicant respectfully requests entry and consideration of the Declaration under 37 C.F.R. § 1.132 filed February 15, 2007. Once the Declaration evidence is

considered in the proper context, it is respectfully submitted that the present claims are patentable over the cited prior art, and withdrawal of the foregoing rejection under 35 U.S.C. § 103(a) is respectfully requested.

II. New Claims 11 and 12

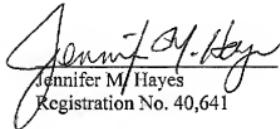
New independent claim 11 further characterizes the polymerizable compound having the perfluoroalkyl or perfluoroalkenyl group and the acrylate or methacrylate group, which compound is specifically selected from the group consisting of (meth)acrylates represented by Formulae (1) to (6). New claim 11 includes all of the limitations of claim 1, and is therefore patentable for the same reasons that claim 1 is patentable over the cited prior art. Additionally, Applicants urge separate patentability of claim 11 as requiring combination with the specific (meth)acrylates as set in Formulae (1) to (6). New claim 12 depending from claim 11 further characterizes the cationic surfactant.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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